



*Patricia Lewis*  
*1717/appeal*  
PATENT  
P55971  
*Brief*  
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*7.27.02*

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF APPEALS AND INTERFERENCES**

In re Application of:

Appeal No.

KI-SEON KIM et al.

Serial No.: 09/503,240

Examiner: FISHER, MICHAEL

Filed: 14 February 2000

Art Unit: 3636

For: MONITOR CASE COMPRISING FACILE DETACH STRUCTURE

**Attn: Board of Patent Appeals & Interferences**

**APPEAL BRIEF**

Assistant Commissioner for Patents  
Washington, D.C. 20231

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Sir:

Pursuant to Applicant's Notice of Appeal filed on 22 May 2002, Applicant hereby appeals to the Board of Patent Appeals and Interferences from the final rejection of claims 1 through 25 in a final office action mailed on 15 January 2002 (Paper No. 8).

Folio: P55971

Date: 7/22/02

I.D.: REB/SS/sb

*OK*

## **I. REAL PARTY IN INTEREST**

Pursuant to 37 CFR § 1.192(c)(1)(as amended), the real party in interest is:

SamSung Electronics Co., Ltd.,  
#416, Maetan-dong, Paldal-gu,  
Suwon-city, Kyungki-do, Republic of KOREA

The inventor executed an Assignment dated 14 February 2000, which was recorded in the U.S. Patent & Trademark Office on 14 February 2000 at Reel 010614, frame 0028.

## **II. RELATED APPEALS AND INTERFERENCES**

There are no other appeals and interferences known to Appellant, Appellant's legal representatives, or assignee, which will directly affect, be directly affected by or have a bearing on the Board's decision in the pending appeal.

## **III. STATUS OF CLAIMS**

Claims 1 through 25 are pending in this application. Claims 1 through 25 were all finally rejected in a final office action (Paper No. 8). A Request for reconsideration was considered but did not place the application in condition for allowance (Paper No. 10). Claims 1 through 25 are appealed herein.

#### **IV. STATUS OF AMENDMENTS**

An Amendment to claim 7 was requested in Applicant's Amendment filed on 16 October 2002 in response to a first Office action mailed on 17 July 2001 (Paper No. 5). No claim amendment was requested thereafter.

#### **V. SUMMARY OF INVENTION**

Referring to figure 3, a monitor 50 includes a front casing 51, a cathode ray tube 52 engaged to the back of the front casing 51, and a rear casing 53 integrally engaged with the front casing 51 for protecting the inner elements of the monitor from an external impact. (page 6, lines 11-13).

A plurality of snap portions (or indent portions) 60 are backwardly protruded from the upper portion of the back of the front casing 51. In addition, a plurality of engaging portions 70 (Figure 4) are formed at the front upper portion of the rear casing 53. Therefore, the engaging portions 70 are engaged to the snap portions 60, so that the front casing 51 and rear casing 53 are integrally engaged. (page 6, lines 14-17).

In addition, an engaging pin 80 is protruding from both rear lower portions of a rim portion of the front casing 51. A receiving hole 90 (figure 7) is formed at

both front lower portions of the rear casing 53. Therefore, since the engaging pin 80 is engaged into the receiving hole 90, the lower portions of the front and rear casings, 51 and 53 respectively, are engaged. In addition, since the snap pin 100 is inserted into the receiving hole 90, the front casing 51 is not easily disassembled from the rear casing 53. (page 6, line 18 through page 7, line 1).

The monitor according to the present invention provides a casing capable of simplifying an assembling process, and decreasing the assembling time by having an easier assembling and disassembling operation of the front and rear casing. (page 14, lines 1-2 and page 2, line 22 to page 3, line 2).

## VI. ISSUES

A. An ultimate issue is whether claims 1, 13, 16, and 21-25 were properly rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,233,026 by *Kim and Lee*. This issue subsumes the following subsidiary issues in the context of this case:

1. The Double Patenting Rejection is improper because it fails to satisfy the provisions set forth by the Manual of Patent Examining Procedure

(MPEP) §804.

2. Concerning claims 1, 13, 16, and 21-25, under a 35USC§103 analysis for a double patenting rejection, *Kim et al.* '026 does not teach or suggest all the claimed limitations of the present invention as defined by the claims of *Kim et al.* '026.

3. Concerning Claims 1, 13, 16, and 21-25, the connection of the front case to the rear case of the present invention is not an obvious variation of the connection of a bottom shield with the front case of the patent of *Kim et al.* '026.

4. The examiner failed to show a motivation to combine the patent with a monitor without a shield.

5. The method claims 21-25 were improperly rejected under an obviousness type double patenting rejection because the claims are not obvious and patentable under 35U.S.C. §103(a) over *Kim et al.* '026.

6. Concerning claim 22 of present invention, *Kim et al. '026* does not teach or suggest all the claimed limitations of the present invention as defined by the claims of *Kim et al. '026*.

7. Concerning claim 23, *Kim et al. '026* does not teach or suggest all the claimed limitations of the present invention as defined by the claims of *Kim et al. '026*.

8. Concerning claim 24, *Kim et al. '026* does not teach or suggest all the claimed limitations of the present invention as defined by the claims of *Kim et al. '026*.

B. Another ultimate issue is whether claims Claims 1, 16, and 21 were properly rejected under 35 U.S.C. §103(a) as being unpatentable over Beak (U.S. Patent 5,863,106). This issue subsumes the following subsidiary issues in the context of this case:

1. Whether *Beak '106* contains all elements (limitations) of the claimed in-

vention of claims 1, 16, 21.

2. The method claim 21 was improperly rejected under 35 U.S.C. §103(a) over *Beak '106*.

3. Whether the obviousness rejection of claims 1, 16, and 21 can be sustained when the record contains no findings on the ordinary level of skill in the art and lacks substantial evidence to support such findings if they had been made.

4. Whether the obviousness rejection of claims 1, 16, and 21 is supported by findings and evidence of a specific teaching, suggestion, or motivation in the prior art to modify and adapt *Beak '106* to arrive at Appellant's specific device.

## VII. GROUPING OF THE CLAIMS

Different references were cited against different claims and there are differences in the different claim rejections. Accordingly, the Appellant argues and therefore groups the claims as follows:

- Apparatus claims 1-12, and 16-20
- Apparatus claims 13-15

- Method claims 21 and 25
- Method claim 22
- Method claim 23
- Method claim 24

## **VIII. ARGUMENT**

### **A. The Double Patenting Rejection**

The examiner stated that claims 1, 13, 16, and 21-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,233,026 by Kim and Lee (*Kim et al.* '026). The examiner admits that the conflicting claims are not identical but states that they are not patentably distinct from each other. As seen below, the obviousness type double patenting rejection is improper.

**1. The Double Patenting Rejection is improper because it fails to satisfy the provisions set forth by the Manual of Patent Examining Procedure (MPEP) §804.**



Concerning claims 1, 13, 16, and 21-25, respectfully, the rejection set forth in Paper No. 5, 8, and 10 and the Examiner's explanation of that rejection, is notably devoid of the requirements mandated for an imposition of obviousness-type double patenting rejection as set forth in the MPEP §804. As mentioned in the MPEP §804, since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for 35 U.S.C. §103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. §103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

(a) A determination of the scope and content of the patent claim(s) of *Kim et al.* '026 relative to each of the **claims** rejected in this application; (emphasis added)

(b) A determination of the differences between the scope and content of the applied patent claim(s) of *Kim et al.* '026 and the prior art as determined in (A) and the claim rejected in the above-captioned application;

(c) A determination of the level of the ordinary skill in prior art; and

(d) An evaluation of any objective indicia of non-obviousness.

The non-obviousness type double patenting rejection set forth in Paper No. 5, 8, and 10 and the Examiner's explanation of that rejection is also completely devoid of any statement by the Examiner as suggested by §804 of the *MPEP*, such as:

(a) The differences between the inventions defined by their conflicting claims, namely a comparison of the applied claims of the *Kim et al.* '026 patent and each of the rejected claims in the above-captioned application; and

(b) The reasons why a person of ordinary skill in art would conclude that the invention defined in the claim at issue is an obvious variation of the invention defined in the claim of the patent.

The *Manual of Patent Examining Procedure* §804 expressly explains the four factual inquiries to be undertaken by the Examiner, as listed above as paragraphs (a) through (d). None of these factual inquiries has either been made or explained in Paper Nos. 5, 8, 10. Moreover, Paper Nos. 5, 8, 10 are devoid of any clear explanation of either the differences between the inventions defined by

the conflicting claims or any explanation of the reasons why person of ordinary skill of art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in the claim in the patent. Respectfully, in short, the Examiner has not only failed to comply with the requirement for the imposition of the obviousness-type double patenting rejection as outlined by §804 of the *Manual*, but has failed to identify the particular parts of each claim applied from *Kim et al.* '026 and comparable limitations of the Applicant's rejected claims.

The Examiner has relied upon the disclosure of *Kim et al.* '026, and specifically, the drawings, as prior art, despite the express provision against this set forth in the *Manual of Patent Examining Procedure*, §804.

For example, in paper number 8 (page 2), the examiner starts by saying “Although the conflicting claims are not identical, they are not patentably distinct from each other because all claims are directed toward a monitor case with snap fittings...” This generalized statement provides no proof in the claims or to what particular elements the examiner is referring to as the elements of comparison. The examiner in his proof refers exclusively to comparison of the figures of the patent and the present application (“..., the lower fitting being substantially the same as

can be seen by comparing fig 6 of the instant application with fig 4 of the patent, with the upper fitting being the same as can be seen by comparing fig 3 of the instant application with fig 3 of the patent”). It is improper for the examiner to have used the figures as comparison. The disclosure of a prior art patent or application may be used as a basis for rejection only to the extent that it is claimed. *In re Vogel*, 422 F.2d 438, 164 USPQ 619, 622 (C.C.P.A. 1970). Further, looking at the claims of the patent and the present application, it is not clear what specifically, the examiner is referring to as “the snap fitting, upper fitting, and lower fitting” as related to the claims of the present invention. The Examiner must provide specific reasons to support the obviousness type rejections. *Ex parte Humphreys*, 24 USPQ 2d 1255, 1262 (B.P.A.I. 1992).

As stated above, the determination of the level of ordinary skill was not provided by the examiner. The examiner must determine the level of ordinary skill in the specific art under consideration to put the examiner in a similar position to that the inventor faced at the time of making of the invention. Several factors may illuminate that inquiry, including an examination of the type of skills needed to understand the patent disclosure, the type of art applied to the application in the Patent and Trademark Office, and the areas of expertise of witnesses who are

recruited to testify concerning the obviousness of the invention. *Orthopedic Equipment Co. v. United States*, 702 F.2d 1005, 1009, 217 USPQ 193, 196 (Fed. Cir. 1983). Other factors may be used for the determination. *Custom Accessories Inc. v. Jeffery-Allan Indus.*, 807 F.2d 955, 1 USPQ 2d 1196, 1201 (Fed. Cir. 1986).

The Examiner has failed in his burden for supporting an obviousness type double patenting rejection. Therefore, the examiner has failed to prove a *prima facie* case of obviousness type double patenting.

**2. Concerning claims 1, 13, 16, and 21-25, under a 35USC§103 analysis for a double patenting rejection, *Kim et al.* '026 does not teach or suggest all the claimed limitations of the present invention as defined by the claims of *Kim et al.* '026.**

As mentioned in claims 1, 13, 16, and 21, the engaging pin (reference 80 of the present invention) at the lower rear surface of the front casing (reference 51 of the present invention) is not mentioned in the claims of *Kim et al.* '026. For

example in claim 10 of *Kim et al.* '026, it is mentioned that “a front case having a rear side and a pair of guide rails extending rearward from the corners on said rear side thereof...” The pair of guide rails as seen in col. 4, lines 31-34 of *Kim et al.* '026, refers to reference 52 which accepts protruding ribs 56. On the other hand, in the present invention in claim 1 for example, the first hole of the lower portion of the front surface of the rear casing, is separately engaged to the engaging pin and the snap pin engages the first hole accommodating the prevention of the engaging pin from detaching from the first hole.

Furthermore, Applicant's independent apparatus claims 1, 13 and 16, and 21-25 illustrate an apparatus that is structurally, functionally and operationally different from the combination set forth in the claims of *Kim et al.* '026. Whereas Applicant defines a novel combination of a front casing, rear casing and an engaging snap pin, *Kim et al.* '026 defines a different front case section, rear case section, first guide and second guide means, in conjunction with a snapping device pull for engagingly locking [a] printed circuit board. In fact *Kim et al.* '026 is teaching away from the claimed invention by disclosing the snap engaging bottom shield instead of the engaging of the snap engaging of the bottom shield. All of the claims of *Kim et al.* '026 (claims 1-23) explicitly teach a “bottom shield” that

snap fits with the front case.

**3. Concerning Claims 1, 13, 16, and 21-25, the connection of the front case to the rear case of the present invention is not an obvious variation of the connection of a bottom shield with the front case of the patent of *Kim et al.* '026.**

The examiner mentions on page 4 of paper number 8 that the art shows the snapping of the shield to a case and since a monitor without a shield is well known in the art, it would have been obvious to make the same case without a shield and without the snap fittings with which it is secured. As mentioned in all the claims of *Kim et al.* '026, in column 1, lines 15-17 of U.S. Patent 6,233,026 mentions that the bottom shield which easily engages with a front case. *Kim et al.* '026 is even entitled "Monitor Comprising Snap Engaging Bottom Shield." (emphasis added). The presently claimed invention specifically mentions the front case snap fitting with the rear case and not the front case snap fitting with the bottom shield. There is a structural difference between the disclosure of the prior art patent to the extent that it is claimed in the presently claimed invention.

As mentioned in MPEP§804, the obviousness type double patenting parallels the guidelines for a 35USC§103 rejection. According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As required in the third element of the *prima facie* case, the prior art references do not teach or suggest the limitation of the front case connection with the rear case but instead shows specifically the bottom shield with the front case in the patent. In paper number 8, page 4, the Examiner states "As a computer without a shield is well known, it would be obvious to make the same case without a shield and without the snap fittings with which it is secured." The MPEP §706.02(j) demands that "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the



prior art and not based on applicant's disclosure.” The examiner, instead, is using his own knowledge instead of using the references that are being relied upon.

**4. The examiner failed to show a motivation to combine the patent with a monitor without a shield.**

Respectfully, the examiner failed to show a motivation to combine the patent with a monitor without a shield. “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability. *In re Dembiczak*, 50 USPQ.2d 1614 (Fed. Cir. 1999). As mentioned above, the examiner could only state in paper number 8, page 4, “As a computer without a shield is well known, it would be obvious to make the same case without a shield and without the snap fittings with which it is secured.” No motivation to have such a combination was ever made.

**5. The method claims 21-25 were improperly rejected under an obviousness type double patenting rejection because the claims are not**

**obvious and patentable under 35U.S.C.§103(a) over *Kim et al.* '026.**

Concerning method claims 21-25, respectfully, the Applicant's process claims 21-25 were improperly rejected by the apparatus claims of *Kim et al.* '026; these claims are statutorily different in class and in subject matter. Respectfully, the Examiner has neglected to explain either the application of *Kim et al.* '026 or his interpretation of those claims to support a comparison of each of the limitation set forth in the Applicant's method claims 21-25. For example in paper number 8, page 2, the Examiner stated concerning claims 21-25, "...the method of claims 21-25 could be used to produce the case as claimed in the patent."

Further, the method claims were not proven by the examiner to be inherent in the apparatus claims as mentioned in the MPEP §2112.02.

Further, not all the claim limitations of claims 21 and 25 are not taught or suggested by *Kim et al.* '026. For example, *Kim et al.* '026 does not teach or suggest the "forming a front casing ... forming a rear casing ... forming a snap pin." Further, there is no teaching or suggestion of the snap pin comprising of "forming a polygonal upper body ... forming a lower body ... dividing one end of lower body ... forming a connection portion." Respectfully, the examiner has

failed to make a complete analysis in the rejection.

Based on the above arguments, claims 21 and 25 stand and fall separately from the other claims.

**6. Concerning claim 22 of present invention, *Kim et al. '026* does not teach or suggest all the claimed limitations of the present invention as defined by the claims of *Kim et al. '026*.**

As seen in claim 22, the snap portion is formed by “forming an elastic plate by cutting away a part of an inner structure of said snap portion; perforating a first aperture in a rectangular shape at an intermediate portion of the elastic plate; and forming a slant surface at one end of said snap portion at a certain angle.” These limitations are taught or suggested by the by the claims defined by *Kim et al. '026*.

Based on the above arguments, claim 22 stands and fall separately from the other claims.

**7. Concerning claim 23, *Kim et al. '026* does not teach or suggest**

**all the claimed limitations of the present invention as defined by the claims of *Kim et al. '026.***

Claim 23 of the present inventions defines, an engaging portion, at the upper front surface of the rear casing, forms “a first detent fixed by the first aperture of said snap portion and a pair of guides formed in both directions of the first detent, the first detent stably engaging with the snap portion.” *Kim et al. '026* as defined by its claims, does not teach or suggest the limitations of claim 23.

Based on the above arguments, claim 23 stands and fall separately from the other claims.

**8. Concerning claim 24, *Kim et al. '026* does not teach or suggest all the claimed limitations of the present invention as defined by the claims of *Kim et al. '026.***

Claim 24 of the present invention, defines “the distance between the guides is larger than the width of the snap portion, and both sides of the snap portion contact with the inner surfaces of the guides.” Nowhere in *Kim et al. '026* as defined by its claims, does it teach or suggest the limitation of claim 24.

Based on the above arguments, claim 24 stands and fall separately from the other claims.

### **B. REJECTION OF CLAIMS (35 U.S.C. § 103)**

Claims 1, 16, and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Beak (U.S. Patent 5,863,106, referred to hereafter as *Beak '106*).

According to MPEP 706.02(j), a *prima facie* case of obviousness under 35 U.S.C. §103 must be established by the examiner.

**1. *Beak '106* does not teach or suggest all the claim elements of the present invention.**

Concerning Claims 1, 16, and 21, the examiner mentions that *Beak '106*

discloses a monitor which includes an engaging pin (11 and 11') at the bottom of the front case which is received in a slot in the rear case (42, 42'). Respectfully, however, as pointed out in *Beak '106* in col. 3, lines 20-30, and lines 58-65, and figure 3, reference 11 and 11' holds a printed circuit board (PCB) 31 and not the rear case section. Member 42 and 42' do not receive reference 11 and 11', but they receive the printed circuit board 31. In col. 1, lines 1-10 of *Beak '106*, it mentions that the engaging pin relates to a structure affixing a printed circuit board within a monitor case. In col. 4, lines 36-40 of claim 1 of *Beak '106*, it states that the first guide affixes the printed circuit board. Therefore, *Beak '106* discloses a different structure than the present invention, and so does not teach or suggest the claimed present invention.

The examiner on page 4 of paper number 8 states that the unnumbered features around the case next to the actual number 11, not feature 11 are also engaging pins. However, if these are also engaging pins, then there is no mention of the snap pins. Even if the pins around the periphery and feature 11 are two different types of pins (one being the snap pin and the other the engaging pin), one pin does not prevent the other pin from detaching the front case from the rear case. It is not clear from the drawing alone that the pins around the periphery of the case

can prevent the case from disengaging. As shown above, feature 11 is involved in holding the printed circuit board in place. Therefore, *Beak '106* does not teach or suggests a snap pin that prevents the engaging pin from detaching as mentioned in claim 1 of the present invention. Both the snap pin and the engaging pins connect between the front case and rear case. *Beak '106* does not teach or suggest both structures interacting together in the manner presented in the claims of the present invention.

Furthermore, *Beak '106* does not teach or suggest the relationship of the engaging pin (80) at the lower rear surface of the front casing (51), the snap pin (100), and the first hole (90) on the lower portion of the front surface of the rear casing (53). As mentioned in claim 1, "...a front casing having ...at least one *engaging pin* at a lower rear surface of said front casing...a rear casing having... at least one *first hole* formed at a lower portion of the front surface, said rear casing integrally engaged with said front casing in such a manner that the *first hole* is separately engaged to the *engaging pin*...a *snap pin* engaging in the *first hole* accommodating the prevention of the *engaging pin* from detaching from the *first hole* when the *engaging pin* of the front casing is integrally engaged into the *first hole* of said rear casing." (emphasis added). In *Beak '106*, the engaging pin of the

front case does not separately engage with the first hole of the rear case since guide rails 11 and 11' (correlated to the engaging pins by the Examiner) do not even go into the guide ribs 42 and 42' (correlated to the first hole by the Examiner), but instead goes into the printed circuit board 31. Further, in the present invention, the snap pin provides a further connection to the same first hole that is connected already engaging with the first hole. Therefore, the same first hole accommodates the engagement of the engaging pin and the snap pin. *Beak '106*, however does not teach or suggest the snap pin engaging with the first hole. As seen in *Beak '106*, the first hole (guide ribs 42 and 42') is engaged with the printed circuit board 31 and not the snap pin (the examiner correlates the snap pin to the receiving section of the slot (below feature 12 of Fig. 4)) of *Beak '106* as seen in paper number 8, page 4 when the examiner states that it engages the engaging pin and hold it in place). The receiving section is not engaged with the same first hole (ribs 42 and 42' of *Beak '106*) and the engaging pin (11 and 11' of *Beak '106*) as seen in Fig. 4 of *Beak '106*. Furthermore, nowhere in the reference of *Beak '106*, does it teach or suggest, that the receiving section will prevent the engaging pin (feature 11 and 11' of *Beak '106*) from detaching. The receiving section has no contact with reference 11 as seen in Fig. 4 of *Beak '106*. No mechanism can be



seen to teach or suggest that there is a “prevention from detaching” by the receiving section of the slot (42 and 42' of *Beak '106*) of the rear case in figure 4 of *Beak '106*. Therefore, *Beak '106*, as mandated by MPEP §706.02(j), does not teach or suggest a snap pin preventing the engaging pin of the front case from detaching from the first hole while it is also engaged with the first hole of the rear case.

Claims 13-15 stand and fall separately from the other claims because in the above rejection, claims 13-15 are not involved, but in the double patenting rejection, claims 13-15 are involved as shown in the arguments mentioned in the double patenting rejection arguments.

**2. The method claim 21 was improperly rejected under 35 U.S.C. §103(a) over *Beak '106*.**

Concerning method claim 21, respectfully, the Applicant's process claim 21 were improperly rejected by the apparatus claims of *Beak '106*; these claims are statutorily different in class and in subject matter. Respectfully, the Examiner has

neglected to explain either the application of *Beak '106* or his interpretation of those claims to support a comparison of each of the limitation set forth in the Applicant's method claim 21. For example in paper number 8, page 4, the Examiner stated concerning claim 21, "The method of claim 21 would produce this configuration and is therefore inherently disclosed."

Further, the method claims were not proven by the examiner to be inherent in the apparatus claims as mentioned in the MPEP §2112.02.

Further, not all the claim limitations of claim 21 is not taught or suggested by *Beak '106*. For example, *Beak '106* does not teach or suggest the "forming a front casing ... forming a rear casing ... forming a snap pin." Respectfully, the examiner has failed to make a complete analysis in the rejection.

### **3. The PTO Failed To Make Specific Findings On the Ordinary Level of Skill**

The final rejection is based on the ordinary level of skill in the pertinent art. Yet, the record contains no evidence, and no findings, as to that level of skill. The rejection does not even identify the pertinent art. (Is it the monitor art? Some other art?) Those defects undermine the rejection.

*In Dembiczak, supra*, the Federal Circuit overturned an obviousness rejection by the PTO because of its failure to make the kind of obviousness legal analysis commanded in *Graham v. John Deere Co.*, 376 U.S. 1, 17-18 (1966). Such an analysis must begin with making specific findings of fact regarding the level of ordinary skill in the art.<sup>1</sup> The *Dembiczak* Court said (175 F.3d at 1000-01, 50 USPQ2d at 1618):

The Commissioner of Patents and Trademarks (“Commissioner”) attempts to justify the Board's decision on grounds different from that relied upon by the Board, arguing that one of ordinary skill in the art would have been motivated to combine the references. Of course, in order to do so, the Commissioner must do what the Board did not do below: make specific findings of fact regarding the level of skill in the art (“a designer and manufacturer of trash and leaf bags, particularly one specializing in the ornamental and graphic design of such bags”) ....

See also *In re Kaplan*, 789 F.2d 1574, 1580, 229 USPQ 678, 683 (Fed. Cir. 1986)

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<sup>1</sup> See also *In re Mayne*, 104 F.3d 1339, 1341, 41 USPQ2d 1451, 1453 (Fed. Cir. 1997); *In re Huang*, 100 F.3d 135, 138, 40 USPQ2d 1685, 1688 (Fed. Cir. 1996).

(“Even if obviousness of the variation is predicated on the level of skill in the art, prior art evidence is needed to show what that level of skill was.”).

Since any obviousness analysis present here rests on nonexistent findings and nonexistent evidence as to the level of ordinary skill in the art, the rejections are faulty and must be reversed.

#### **4. The Rejection Is Defective for Lack of a *Graham-Gechter-Dembiczak* Analysis of Obviousness**

The final rejection has substituted speculation and inference for the detailed factual and legal analysis which the Federal Court requires. The rejection is *not* based on a factual analysis of the record, stated in sufficient detail to elucidate the Examiner's reasoning by which he reached his ultimate factual and legal conclusions. There is not a proper analysis. That procedure and methodology cannot withstand scrutiny under *Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997), and *In re Dembiczak*, 175 F.3d 997, 50 USPQ 1614 (Fed. Cir. 1999).

*Gechter* holds that the PTO, like other administrative agencies, has “a duty to provide reviewing courts with a sufficient explanation for [its] decisions so that those decisions may be judged against the relevant statutory standards, and that

failure to provide such an explanation is grounds for striking down the action.”  
116 F.3d at 1459.

The kind of obviousness analysis required here is summarized in  
*Dembiczak, supra*, 175 F.3d at 998:

The ultimate determination of whether an invention is or is not obvious is a legal conclusion based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness.

These are the well-known *Graham v. Deere* factors. The four determinations listed above must rest on substantial evidence of record. *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000). There is no such supporting record here.

Conspicuously lacking in support of the instant final rejection are analyses of factors (2) and (4), substantial evidence in the record as to the conclusions (absent here) regarding those factors, and a reasoned explanation as commanded in *Gechter*. The record before the Board shows only the Examiner's *assertion* that the present invention is obvious from *Beak '106*. No proper reasoned basis is provided for the assertion, nor any *Graham v. Deere* analysis of the facts. An applicant is entitled to a patent *unless* the Examining Staff establishes, *prima*

*facie*, that he is not entitled to a patent because of obviousness. It is the Examining Staff's burden to establish obviousness over the prior art on the basis of a preponderance of evidence. *In re Dembiczak*, 175 F.3d 994, 1001, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999); *In re Epstein*, 32 F.3d 1559, 1564 (Fed. Cir. 1994); *In re Rijckeart*, 9 F.3d 1551, 1552, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Yet, respectfully, the Examining Staff did not meet that burden here.

## IX. CONCLUSION

In view of the law and facts stated herein as well as all the foregoing reasons, Appellant believes that the rejection is improper and respectfully requests that the Board refuse to sustain the outstanding rejection of claims 1, 13, 16, and 21-25 under the (non-statutory) judicially created doctrine of obviousness-type double patenting and of claims 1, 16, and 21 under 35 U.S.C. §103.

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## **X. APPENDIX**

### **CLAIMS UNDER APPEAL (1-25)**

1           1. A monitor, comprising:

2           a front casing having at least one snap portion at an upper rear surface of  
3           said front casing and at least one engaging pin at a lower rear surface of said front  
4           casing;

5           a rear casing having at least one engaging portion at an upper front surface  
6           detachably engaging with the snap portion of said casing, and at least one first  
7           hole formed at a lower portion of the front surface, said rear casing integrally  
8           engaged with said front casing in such a manner that the first hole is separately  
9           engaged to the engaging pin, said front and rear casings enclosing a cathode ray  
10          tube; and

11          a snap pin engaging in the first hole accommodating the prevention of the  
12          engaging pin from detaching from the first hole when the engaging pin of the front  
13          casing is integrally engaged into the first hole of said rear casing.

1           2. The monitor of claim 1, wherein said snap portion includes an elastic



2 plate formed by cutting away a part of an inner structure of said snap portion, a  
3 first aperture rectangular in shape formed at an intermediate portion of the elastic  
4 plate and a slant surface formed at one end of said snap portion at a certain angle.

1 3. The monitor of claim 2, wherein said engaging portion includes a first  
2 detent fixed by the first aperture of said snap portion and a pair of guides formed  
3 in both directions of the first detent, the first detent stably engaging with the snap  
4 portion.

1 4. The monitor of claim 3, wherein the front portion of the first detent is  
2 circular, and the rear portion of the first detent includes a vertical wall.

1 5. The monitor of claim 3, wherein the distance between the guides is larger  
2 than the width of the snap portion, and both sides of the snap portion contact with  
3 the inner surfaces of the guides.

1 6. The monitor of claim 5, wherein the heights of the guides are less than  
2 the height of the first detent, and the lengths of the guides are less than the length

3 of the first detent.

1 7. (Amended) The monitor of claim 6, wherein when the front and rear  
2 casing are integrally engaged, a certain gap is formed between the front and rear  
3 casings, so that a certain tool including a driver is inserted into the gap when  
4 disassembling the front and rear casings.

1 8. The monitor of claim 1, wherein the engaging pin is a rectangular bar,  
2 and a pair of first shoulder portions reinforcing the engaging pin are formed at the  
3 upper end of the engaging pin, and a second detent is formed at an end portion of  
4 the lower surface of the engaging pin.

1 9. The monitor of claim 8, wherein a groove is formed at a top portion of an  
2 outer wall of the first hole, and a second aperture is formed at a portion  
3 backwardly distanced from the groove, and a pair of second shoulder portions  
4 each having a slant surface are formed at the bottom portion of the outer wall of  
5 the first hole, and the second detent of the engaging pin is engaged and  
6 disconnected with the second shoulder portions.

1           10. The monitor of claim 9, wherein said snap pin further comprising:  
2           a polygonal upper body;  
3           a lower body formed at a lower portion of said upper body and having one  
4           end divided into first and second members; and  
5           a connection portion accommodating integral connection of the upper and  
6           lower bodies.

1           11. The monitor of claim 10, wherein a third shoulder portion is  
2           downwardly protruding from one end of said upper body and is fixed at a second  
3           hole of the top portion of the outer wall of the first hole.

1           12. The monitor of claim 10, wherein the width of the lower body is less  
2           than the distance between the first shoulder portions and the lower body is  
3           received between the first shoulder portions when the first member is substantially  
4           parallel with the second member.

1           13. A monitor having a cathode ray tube, comprising:

2 a front casing;  
3 a rear casing engaging with said front casing enclosing the cathode ray tube;  
4 an indent portion protruding from said front casing and said rear casing in a  
5 certain direction;  
6 a detent portion forming at the opposite casing of said indent portion, said  
7 indent portion elastically transforming and inserting into said detent portion, and  
8 elastically transforming in the same direction as the engaging direction for thereby  
9 disassembling the front and rear casings; and  
10 a guide forming at said detent portion accommodating the direction of said  
11 indent portion to said detent portion in an engaging position.

1 14. The monitor of claim 13, wherein an engaging groove forming at said  
2 indent portion, a detent of said detent portion having a circular wall formed in the  
3 direction of the engaging groove and a vertical wall in the opposite direction,  
4 when engaging said indent portion with said detent portion, the indent portion is  
5 transformed by the circular wall, the detent is received into the engaging groove of  
6 the indent portion, and when a certain separation force is applied, the vertical wall  
7 is engaged with the engaging groove for thereby supporting the front and rear

8 casings.

1 15. The monitor of claim 14, wherein a gap is formed between said front  
2 casing and said rear casing allowing a certain tool to be inserted into the gap  
3 thereby pushing the indent portion, and transforming the detent so that the front  
4 and rear casings are separated from each other.

1 16. A monitor having a front casing and a rear casing for receiving a  
2 cathode ray tube, comprising:

3 an engaging pin extending from one of the front and rear casings in the  
4 direction of the opposite casing;

5 a wall surrounding a first hole engaging with said engaging pin when the  
6 engaging pin slides to the first hole; and

7 a snap pin engaging in said wall surrounding the first hole when said  
8 engaging pin is engaged in the first hole accommodating the prevention of said  
9 engaging pin from disengaging from said wall.

1 17. The monitor of claim 16, further comprising:

2 a groove forming at the top portion of said wall surrounding the first hole;  
3 a first aperture forming at a portion backwardly distanced from the groove;  
4 a pair of first shoulder portions each having a slant surface forming at a  
5 bottom portion of said wall surrounding the first hole; and  
6 a first detent of the engaging pin connecting and disconnecting with the first  
7 shoulder portions.

1 18. The monitor of claim 16, wherein said engaging pin is a rectangular bar  
2 with a pair of second shoulder portions forming at the upper end of said engaging  
3 pin, and a second detent forming at an end portion of the lower surface of said  
4 engaging pin.

1 19. The monitor of claim 16, wherein said snap pin further comprising:  
2 a polygonal upper body;  
3 a lower body formed at a lower portion of said upper body and having one  
4 end divided into first and second members; and  
5 a connection portion accommodating integral connection of the upper and  
6 lower bodies.

1           20. The monitor of claim 16, further comprising:

2           an indent portion protruding from said front casing and said rear casing in a  
3           certain direction;

4           a detent portion formed at the opposite casing of said indent portion, said  
5           indent portion elastically transformed and inserted into said detent portion, and  
6           elastically transforming in the same direction as the engaging direction for thereby  
7           disassembling the front and rear casings; and

8           a guide formed at said detent portion accommodating the direction of said  
9           indent portion to said detent portion in an engaging position.

1           21. A method of constructing a monitor housing, comprising the steps of:

2           forming a front casing having at least one snap portion at an upper rear  
3           surface of said front casing and at least one engaging pin at a lower rear surface of  
4           said front casing;

5           forming a rear casing having at least one engaging portion at an upper front  
6           surface detachably engaging with the snap portion of said front casing, and at least  
7           one first hole formed at a lower portion of the front surface, said rear casing

8 integrally engaging with said front casing in such a manner that the first hole is  
9 separately engaged to the engaging pin, said front and rear casings enclosing a  
10 cathode ray tube; and

11 forming a snap pin engaging in the first hole accommodating the prevention  
12 of the engaging pin from detaching from the first hole when the engaging pin of  
13 the front casing is integrally engaged into the first hole of said rear casing.

1 22. The method of claim 21, wherein forming the snap portion comprising  
2 the steps of:

3 forming an elastic plate by cutting away a part of an inner structure of said  
4 snap portion;

5 perforating a first aperture in a rectangular shape at an intermediate portion  
6 of the elastic plate; and

7 forming a slant surface at one end of said snap portion at a certain angle.

1 23. The method of claim 22, wherein said engaging portion forms a first  
2 detent fixed by the first aperture of said snap portion and a pair of guides formed  
3 in both directions of the first detent, the first detent stably engaging with the snap



4 portion.

1 24. The method of claim 23, wherein the distance between the guides is  
2 larger than the width of the snap portion, and both sides of the snap portion  
3 contact with the inner surfaces of the guides.

1 25. The method of claim 21, wherein forming said snap pin further  
2 comprising the steps of:

3 forming a polygonal upper body;

4 forming a lower body at a lower portion of said upper body;

5 dividing one end of said lower body into first and second members; and

6 forming a connection portion accommodating integral connection of the  
7 upper and lower bodies.



PATENT  
P55971

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

KI-SEON KIM et al.

Serial No.: 09/503,240

Examiner: FISHER, MICHAEL

Filed: 14 February 2000

Art Unit: 3636

For: MONITOR CASE COMPRISING FACILE DETACH STRUCTURE

**TRANSMITTAL OF APPELLANT'S BRIEF FEE**


Assistant Commissioner  
for Patents  
Washington, D.C. 20231

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Sir:

Accompanying this transmittal is a check drawn to the Commissioner of Patents and Trademarks in the amount of \$320.00 for the filing a Brief in support of a Notice of Appeal filed on 22 May 2002. Should any additional fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 in that amount. Please inform the Applicant of any transactions involving the Deposit Account.

Respectfully submitted,

  
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Date: 22 July 2002  
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AF/3636

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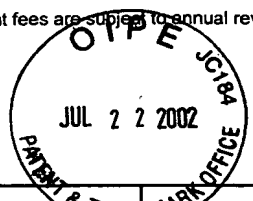
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# FEE TRANSMITTAL

Patent fees are subject to annual revision.



## Complete If Known

Application Number	09/503,240
Filing Date	14 February 2000
First Named Inventor	KI-SEON KIM et al.
Examiner Name	FISHER, MICHAEL J.
Group/Art Unit	3636
Attorney Docket No.	P55971

TOTAL AMOUNT OF PAYMENT MADE (\$)320.00

## METHOD OF PAYMENT (check one)

1. ☐ The Commissioner is hereby authorized to charge indicated fees and credit any over payments to:

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- ☐ Charge Any Additional Fee Required Under 37 C.F.R. §1.16 and 1.17.  
☐ Applicant claims small entity status. See 37 CFR 1.27

## 2. ☒ Payment Enclosed: (CHECK #42778)

☒ Check ☐ Credit Card ☐ Money Order ☐ Other

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity	Small Entity				
Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
101	740	201	370	Utility filing fee	\$
106	330	206	165	Design filing fee	\$
107	510	207	255	Plant filing fee	\$
108	740	208	370	Reissue filing fee	\$
114	160	214	80	Provisional filing fee	\$
SUBTOTAL (1)					(\$) <u>.00</u>

### 2. EXTRA CLAIM FEES

		Extra Claims	Fee from below	Fee Paid
Total claims	-20** =	x	=	
Independent Claims	-3** =	x	=	
Multiple Dependent				=

\*\* or number previously paid, if greater; For Reissues, see below

Large Entity	Small Entity				
Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	
103	18	203	9	Claims in excess of 20	
102	84	202	42	Independent claims in excess of 3	
104	280	204	140	Multiple dependent claim, if not paid	
109	84	209	42	** Reissue independent claims over original patent	
110	18	210	9	** Reissue claims in excess of 20 and over original patent	

SUBTOTAL (2) (\$).00

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity	Small Entity				
Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
105	130	205	65	Surcharge-late filing fee or oath	\$
127	50	227	25	Surcharge-late provisional filing fee or cover sheet	\$
139	130	139	130	Non-English specification	\$
147	2,520	147	2,520	For filing a request for reexamination	\$
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	\$
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	\$
115	110	215	55	Extension for reply within first month	\$
116	400	216	200	Extension for reply within second month	\$
117	920	217	460	Extension for reply within third month	\$
118	1,440	218	720	Extension for reply within fourth month	\$
128	1,960	228	980	Extension for reply within fifth month	\$
119	320	219	160	Notice of Appeal	\$
120	320	220	160	Filing a brief in support of an appeal	\$320.00
121	280	221	140	Request for oral hearing	\$
138	1,510	138	1,510	Petition to institute a public use proceeding	\$
140	110	240	55	Petition to revive - unavoidable	\$
141	1,280	241	640	Petition to revive - unintentional	\$
142	1,280	242	640	Utility issue fee (or reissue)	\$
143	460	243	230	Design issue fee	\$
144	620	244	310	Plant issue fee	\$
122	130	122	130	Petitions to the Commissioner	\$
123	50	123	50	Petitions related to provisional applications	\$
126	180	126	180	Submission of Information Disclosure Statement	\$
581	40	581	40	Recording each patent assignment per property (Times number of properties)	\$
146	740	246	370	Filing a submission after final rejection (37 C.F.R. §1.129(a))	\$
149	740	249	370	For each additional invention to be examined (37 C.F.R. §1.129(b))	\$
Other Fee (specify) _____					\$
Other Fee (specify) _____					\$

\*\* Reduced by Basic Filing Fee Paid

SUBTOTAL (3) \$320.00

## SUBMITTED BY

Typed or Printed Name	Robert E. Bushnell, Esq.			Reg. Number	27,774
Signature		Date	22 July 2002	Deposit Account User ID	

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